

REMARKS

Claims 1-20 and 22 had been pending in the application.

Claims 20 and 22 are rejected under 35 USC 112, second paragraph, as being indefinite. Claims 20 and 22 are cancelled without disclaimer or prejudice.

Claims 1-12, 14 and 16-19 remain rejected under 35 U.S.C. 102(e) as being anticipated by Whitman et al. (6,772,150).

Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitman et al. (6,772,150).

The pending claims remain for reconsideration, which is requested.

Entry of the claim amendments and reconsideration of the amended claims is respectfully requested, because claims rejected for indefiniteness are cancelled, and the remarks clarify the patentably distinguishing features of the present invention over the relied upon references without requiring further search to place the application either in condition for allowance or simplify issues for appeal.

One main issue, with respect to the language of claim 1 and the Office Action rejection relying upon Whitman, is whether clicking on a hyperlink can refer to, or be a reasonable broadest interpretation, as the claimed ***designation of a display form***, namely “***receiving a designation of a second display form from said user***.” According to 37 CFR 1.56(b)(ii), “a prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification ...” However, the Office Action interpretation is not a broadest reasonable interpretation of the language of claim 1 consistent with the specification, because the language of claim 1 expressly requires the limitations of “***receiving a designation of a second display form from said user***” and “***transforming said data ... to indicate said data of said documents to said user in said second display form***.” A benefit of the transformation from the first display form into the second display form is “***to enable said user to select a display item to be utilized as a third search condition in a following processing***.”

The language of claim 1 recites both limitations of “***receiving designation of a second***

display form from said user” and “*extracting data of documents corresponding to said display item selected by said user*,” so it would not be a broadest reasonable interpretation consistent with the specification to equate “*designation of a second display form*” with selection of a hyperlink as a display item, because the language of claim 1 clearly recites that the second display form is designated independently from selecting said display item on the transformed information in the first display form.

In other words, the language of claim 1 provides a first transformation for selecting display item, namely “*transforming said data of said plurality of documents into information to indicate said data of said plurality of documents to said user in a first display form and to enable said user to select a display item*” to be utilized as a second search condition in a following processing.” A benefit of the invention is that the display form is changed from a first display form to a second display form, based upon both the designation of the second display form and the selection of the display item on the transformed information in the first display form. This is achieved by the language of claim 1 providing “receiving designation of a second display form from the user” and “extracting data ... corresponding to said display item selected by said user” from the first display form, and then “*transforming said data of said plurality of documents into information to indicate said data of said plurality of documents to said user in a first display form and to enable said user to select a display item*” to be utilized as a second search condition in a following processing.”

On the other hand, as relied upon by the Office Action Response to Arguments, in Whitman FIG. 8, the user inputs a search condition, such as ‘DOG,’ and then the user can click on a hyperlink as display item, such as display items in “Related Searches,” display items in “Top Matches for this search,” or display items in “Full Results” as search results. This Whitman discussion only shows the concepts of ‘selecting a display item’ or possibly a follow up search by selecting a display item in “Related Searches,” selecting a display item in “Top Matches for this search,” or selecting a display item in “Full Results,” but fails to disclose either expressly or inherently any “designation of a second display form from the user.” In other words, even if clicking on the hyperlink could refer to instructing a further search, such as by clicking on the display item “Walking the Dog” in “Related Searches,” the user **cannot select any display form** of such further search results.

The Office Action Response to Arguments, Argument #1, provides

'Designation' refers to 'the act of indicating or identifying' as described in Merriam-Webster Online dictionary. Whitman's invention receives an act of identifying the search results in a second displayable form which is displayed on the screen. And the user clicks or selects the results on this so-called second display form.

However, the language of claim 1 must be interpreted consistent with other limitations required by claim 1 and consistent with the specification. In other words, the language of claim 1 recites not only "**receiving designation of a second display form from said user,**" but also requires additional limitations of "**extracting data of documents corresponding to said display item selected by said user,**" where the user selects the display item in the first transformation to the first display form, so both of these phrases could not under a broadest reasonable interpretation be interpreted to refer to the same operation consistent with the specification. In other words, the language of claim 1 requires both "designation of a second display form" and "to enable said user to select a display item to be utilized" in "a first display form," both of which cannot be interpreted to be the same, but a broadest reasonable interpretation consistent with the specification would be **selecting a display form from the user for the search results**, namely for "**transforming said data of said documents corresponding to said selected display item into information to indicate said data of said documents to said user in said second display form.**" The language of claim 1 clearly provides "**transforming said data ... to indicate said data to said user in said second display form**" and the second display form is selected by the user. Whitman's FIG. 8 is silent on and fails to disclose, either expressly or inherently, any such transformation in relation to a selected display form for search results.

Further, in the Argument #3 in page 3 of the office action, the Examiner appears to rely upon Whitman Fig. 2. However, Fig. 2 does not relate to the aforementioned feature in claim 1. Namely, Fig. 2 merely indicates a book search screen, none of the display items indicate any search results and the user cannot **select a display form of the search results**, namely Whitman's search screen does not disclose expressly or inherently the claimed "**receiving designation of a second display form from said user.**" In other words, in Whitman's FIG. 2, the user can select only the search method, and the search method is selected only according to query materials, such as title, ISBN or author, but not based on selecting a display form. On the other hand, the aforementioned feature of claim 1 relates to the user's selected display form of

the search results, and is not taught expressly or inherently in Fig. 2 of Whitman.

To establish a prima facie case of anticipation Whitman must disclose either expressly or inherently each and every element of the language of claim 1 (see MPEP 2131). Further, as suggested by MPEP 2131 and 2112, inherency requires the claimed feature to be necessarily present in the prior art even though not expressly discussed. A prima facie case of anticipation based upon Whitman cannot be established, because Whitman's FIGS. 2 and 8, and descriptions thereof, fail to disclose either expressly or inherently by failing to necessarily require the language of claim 1 "**transforming ... in a first display form**" and "**select a display item ... as a second search condition** [in said first display form]... **receiving designation of a second display form ... and transforming ... said selected display item** [in said first display item] **to ... said second display form ... to select a display item to be utilized as a third search condition.**" If as the Examiner suggest, Whitman's FIG. 8 display items (hyperlinks) could correspond to the claimed first display form, and selection of the display items (hyperlinks) would provide further search results, there is no evidence expressly or inherently that such selection of the display item (hyperlink) is same as the claimed "**receiving designation of a second display form**" and "**transforming ... said selected display item** [in said first display item] **to ... said second display form ... to select a display item to be utilized as a third search condition.**" Because, selection of a display item (hyperlink) in Whitman's FIG. 8 leads to a further search, but there is no evidence, either expressly or inherently, of a transformation of the first search results into a second display form to provide display items as "a third search condition."

Withdrawal of the rejection of claim 1 and allowance of claim 1 is requested.

Independent claims 16 and 18 require limitations similar to the discussed limitations of claim 1.

Dependent claims recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependencies from the independent claims. For example, the language of claim 2 provides one or more examples of first and second display forms, which clearly differ from selection of a hyperlink as a display item. Accordingly, dependent claim 2 is allowable.

Withdrawal of the rejection of pending claims and allowance of pending claims is requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,
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